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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. HULL and DAVID R. HANSEN

Appeal 2008-005450
Application 09/684,126
Technology Center 2100

Decided: January 27, 2010

Before JOHN A. JEFFERY, STEPHEN C. SIU, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 56, 59-62, 65-68, 70, and 72-82. Claims 1-55, 57, 58, 63, 64, 69, and 71 have been cancelled (Br. 3). We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We AFFIRM.

Introduction

According to Appellants, the invention relates to an interface, implemented in a computer, for using a graphical user interface to make changes to pages within a document before producing finished output on a production printer (Spec. 3, ll. 4-7). The method and system provides an interface which allows an operator to view applied page features for each page in a document to verify their correct format, page features, etc. before producing the document on a production printer (Abst.).

STATEMENT OF THE CASE

Exemplary Claim

Claim 56 is an exemplary claim and is reproduced below:

> 56. A graphic user interface (GUI) for a printer console for controlling the printing of a document having a plurality of pages, wherein each of the plurality of pages has associated therewith a plurality of media and/or finishing attributes, the graphic user interface comprising:
>
> a page representation for each of the plurality of pages, the page representations being miniature representations of particular pages as they will look when they are printed, wherein the GUI displays more than one page representation simultaneously; and

> a media and/or finishing attributes operator interface operatively coupled to a selected group of the plurality of pages and configured to facilitate at least one of viewing of, adding to, deleting from, and modifying of the media and/or finishing attributes of the selected group of the plurality of pages, wherein the media and/or finishing attributes operator interface operatively coupled to the selected group of the plurality of pages is displayed in response to selections of the page representations for the selected group of the plurality of pages.

Prior Art

Connors	5,600,412	Feb. 4, 1997
Habib	5,694,610	Dec. 2, 1997
Coleman	6,262,732 B1	Jul. 17, 2001
Livingston	6,621,590 B1	Sep. 16, 2003

Rejections

Claims 56, 59-62, 65-68, 70 and 76-82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Livingston, Habib, and Coleman.

Claims 72-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Livingston, Habib, Coleman and Connors.

GROUPING OF CLAIMS

(1) Appellants argue claims 56, 59-62, 65-68, 70, and 76-82 as a group based on arguments set forth for representative claim 56 (Br. 10-13). We therefore treat claims 59-62, 65-68, 70, and 76-82 as standing or falling with representative claim 56.

(2) Appellants argue claims 72-75 for the same reasons argued with respect to independent claim 56 (*see* Br. 13). We therefore treat claims 72-75 as standing or falling with representative claim 56.

We accept Appellants' grouping of the claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE 1

35 U.S.C. § 103(a): claims 56 and 62

Appellants argue the combination of Livingston and Habib does not teach or suggest an operator interface operatively coupled to a selected group of pages (Br. 10). Specifically, Appellants contend that one skilled in the art (1) "knowing that a document can have a plurality of pages according of Livingston," and (2) "knowing that page features of a single page can be viewed by right-clicking on the single page in Habib, . . . would not also know that attributes of a group of pages can be viewed and modified by selecting page representations of the group of pages" (Br. 10).

The Examiner admits that the combination of Livingston and Habib fails to teach attributes of a group of pages that can be viewed and modified by selecting page representations of the groups of pages (Ans. 9). However, the Examiner asserts Coleman was relied on for teaching and suggesting "simultaneously displaying a group of pages" (*id.*). The Examiner concluded that the combination Livingston, Habib and Coleman teaches the features of claims 56 and 62. Further, the Examiner found that Appellants did not address the rejection based on the Coleman references as set forth by the Examiner (*id.*).

Issue 1: Have Appellants shown the Examiner erred in concluding the combination of Livingston, Habib, and Coleman teaches or suggests:

(1) an operator interface operatively coupled to a selected group of pages, and (2) attributes of a group of pages can be viewed and modified by selecting page representations of the *group* of pages?

PRINCIPLES OF LAW

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Discussing the question of obviousness of claimed subject matter involving a combination of known elements, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), explains:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. Ag Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock*[*, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417.

FINDING OF FACTS

We find the facts as follows:

Coleman Reference

1. Shown on desktop 110 of Figure 2 is a representation of a set of pages assembled into a stack 116 (col. 6, ll. 5-7). The set of pages assembled into the stack may be manipulated as a single entity by selecting any page in the stack (col. 6, ll. 9-12). In Figure 2, information corresponding to each page is represented by a miniature replica of the information as it would appear on a printed page (col. 6, ll. 23-26).

ANALYSIS

We agree with Appellants that the mere teaching of a plurality of pages by Livingston, and the mere teaching of viewing page attributes of a single page by right clicking on the single page in Habib, does not cumulatively teach the invention of claims 56 and 62. However, the Examiner did not rely on Livingston as teaching this feature. Instead, the Examiner relied on Coleman for teaching "simultaneously displaying a group of pages" (Ans. 9). In our review of Coleman, we find Coleman teaches a group of pages, as Coleman teaches miniature representations of a set of pages (FF 1). We further find since one of the pages in a stack can be selected to manipulate the stack, a group of pages can be viewed and modified by selecting a page representation of the group of pages (*id.*).

Appellants did not argue the foregoing limitation with respect to the Coleman reference. Moreover, the Examiner found claims 56 and 62 obvious over the *combination* of Livingston, Habib, and Coleman. One

cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

We therefore find Appellants did not specifically address the Examiner's position based on the collective teachings of the references articulated in the rejection. Accordingly, Appellants have failed to persuade us of error in the Examiner's conclusion that the combination of Livingston, Habib, and Coleman teaches or suggests (1) an operator interface operatively coupled to a selected group of pages, and (2) attributes of a group of pages that can be viewed and modified by selecting page representations of the group of pages.

ISSUE 2

35 U.S.C. § 103(a): claims 56, 62, 68, and 70

Appellants next argue the combination of Livingston and Habib does not teach or suggest that the operator interface is displayed upon selection of one or more page representations (Br. 11). Appellants contend that Livingston makes it difficult for a user to apply setting to pages unless the user can remember what the specific pages in the documents look like (*id.*). Appellants contend the Examiner found it would have been obvious to modify the Livingston patent which fails to disclose an operator interface displayed upon page selection using techniques taught by Habib. However, Appellants contend the Examiner's reasons for modifying Livingston are insufficient (*id.*). Indeed, Appellants argue the Examiner has not supplied sufficient reasons for a motivation to combine Livingston and Habib, as (1)

it is not clear what "enhance the printing pages" - the Examiner's reason for motivation - means, and (2) "how right-clicking a page representation, such as that shown by reference numeral 68 in FIG. 3A of the Livingston patent would 'enhance the printing pages'" (Br. 11-12).

Appellants also argue the feature list menu shown by reference numeral 64 of the Livingston patent is displayed at all times (Br. 12). Thus, Appellants argue it is not clear why one skilled in the art would be motivated to modify the teachings of the Livingston to require the display of a menu by right-clicking the page representation (*id.*).

The Examiner found that Livingston and Habib disclose the same field of invention, as both references disclose editing and formatting data in a document and displaying a list of selectable features (Ans. 11). Further, the Examiner found Livingston teaches an attributes operator interface (i.e., the menu list) and Habib teaches the step of right-clicking the mouse (Ans. 11-12). The Examiner concluded modifying Livingston to require the display of a menu by right-clicking the page representation for a benefit of enhancing the representation of the printing page would have been obvious since a motivation to combine the prior art teachings to display the attributes operator interface exists (Ans. 12).

Issue 2: Have Appellants shown the Examiner erred in finding one of ordinary skill in the art would have been motivated to combine Livingston and Habib to teach or suggest an operator interface that is displayed upon selection of one or more page representations?

PRINCIPLES OF LAW

The court in *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) states "the 'motivation-suggestion-teaching' test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims."

ADDITIONAL FINDING OF FACTS

We further find the facts as follows:

Livingston Reference

2. A graphical interface includes a scroll bar 70 that allows a user to select a specific page in a document for a print preview image 68 (col. 4, ll. 5-6; col. 5, ll. 27-29; and FIG. 3A).
3. A list of printer features 64 is displayed in a first portion 50, together with a scroll bar, to allow a user to (1) scan features in the list and (2) select features in the list for modification from their default settings (col. 4, l. 65 to col. 5. l. 1).

Habib Reference

4. By clicking on the rich text edit field 3C04 with a user input device, such as a mouse, the user invokes pop-up menu 3C05 and selects the font item from the menu (col. 5, ll. 64-67).

ANALYSIS

We find Livingston teaches (1) displaying a print preview image 68 (i.e., page representation) and (2) a features list 64 (i.e., an operator

interface) that allows for the selection of features that can be modified (FF 2 - 3). Further, we find Habib teaches or suggests displaying a pop-up menu (i.e., operator interface) upon clicking an item (i.e., edit field 3C04) (FF 4). According to *KSR*, a "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. Additionally, we find that a person of ordinary skill in the art would have possessed the understandings and knowledge reflected in the prior art and therefore, would have been motivated to combine their respective teachings by the general problem to be solved, namely to conserve space on the display. Thus, we find it would have been obvious to a skilled artisan to combine Livingston with Habib so that the feature list 64 (i.e., operator interface) is displayed after clicking (i.e., as in Habib) on the print preview image 68 of Livingston (i.e., the page representation) as space on the graphical user interface would have been saved.

Accordingly, Appellants have not shown the Examiner erred in finding one in ordinary skill in the art would have been motivated to combine Livingston and Habib to teach an operator interface that is displayed upon selection of one or more page representations.

ISSUE 3

35 U.S.C. § 103(a): claims 56, 62, 68, and 70

Appellants argue the Livingston system would not easily be modified to display plural page representations simultaneously as taught by Coleman, because the scroll bar mechanism 70 shown in FIG. 3A of the Livingston patent is conducive to displaying only a single page at time (Br. 12). Thus,

Appellants argue, it would not have been obvious for one of ordinary skill in the art to modify the teachings of Livingston to include the technique taught by Coleman to display multiple pages simultaneously, as required by claims 56, 62, 68, and 70 (*id.* at 13).

The Examiner asserts the Coleman reference, and not the Livingston or Habib reference, was relied upon for teaching simultaneously displaying multiple page representations (Ans. 12-13). The Examiner finds Appellants have not addressed the rejection as set forth by the Examiner (*id.* at 13).

Issue 3: Have Appellants shown the Examiner erred in concluding that it would have been obvious to modify the teachings of Livingston to include the technique of showing multiple pages simultaneously as taught by Coleman?

ANALYSIS

We find displaying multiple page representations is a technique that one of ordinary skill in the art would have recognized would improve teachings of Livingston (*See KSR*, at 417). Indeed, we find it would have been obvious to one of ordinary skill in the art to incorporate the techniques taught by Coleman and Habib into the system of Livingston as it would have enabled a user to view more than one page representation, and to select from the page representations viewed. Accordingly, we find Livingston would have been improved, as the combination would have eliminated the step of utilizing the scroll bar 70 to select a page from multiple pages.

Thus, Appellants have failed to persuade us of error in the Examiner's conclusion that it would have been obvious to modify the teachings of

Livingston to include the technique of showing multiple pages simultaneously as taught by Coleman.

ISSUE 4

35 U.S.C. § 103(a): claims 72-75

The Examiner rejected claims 72-75 under 35 U.S.C. § 103(a) as being unpatentable over Livingston, Habib, Coleman and Connors (Ans. 8). Appellants argue claims 72-75 are patentable for the reasons set forth for the independent claims from which they depend and did not present any new arguments or evidence for these claims (Br. 13). Thus, for the reasons set forth above with regard to Issues 1-3 for independent claims 56, 62, 68, and 70 from which claims 72-75 depend, Appellants have not shown the Examiner erred in rejecting claims 72-75.

CONCLUSION

Appellants have not shown the Examiner erred in finding the combination of Livingston, Habib, and Coleman teaches or suggests: (1) an operator interface operatively coupled to a selected group of pages and (2) attributes of a group of pages can be viewed and modified by selecting page representations of the group of pages.

Further, Appellants have not shown the Examiner erred in finding one of ordinary skill in the art would have been motivated to combine Livingston and Habib to teach or suggest an operator interface that is displayed upon selection of one or more page representations.

Finally, Appellants have not shown the Examiner erred in finding that it would have been obvious to modify the teachings of Livingston to include

the technique of showing multiple pages simultaneously as taught by Coleman.

Accordingly, Appellants have not shown the Examiner erred in rejecting independent claims 56, 62, 68, and 70. Appellants argue claims 56, 59-62, 65-68, 70, and 76-82 as a group (Br. 13). As set forth with respect to Issues 1 -3, Appellants have not shown the Examiner erred in rejecting independent claims 56, 62, 68 and 70 for obviousness over Livingston, Habib and Coleman. Since claims 59-61 and 76-78 depend from independent claim 56; claims 65-67 and 79-81 depend from independent claim 62; and claim 82 depends from independent claim 68; and none of claims 59-61, 65-67, and 76-82 were separately argue but instead argued on the basis of their respective independent claim, Appellants have not shown the Examiner erred in rejecting claims 59-61, 65-67, and 76-82.

Accordingly, Appellants have not shown the Examiner erred in rejecting claims 56, 59-62, 65-68, 70 and 76-82 under 35 U.S.C. § 103(a) for obviousness over Livingston, Habib, and Coleman.

Additionally, since claim 72-75 were argued on the basis of independent claims 56, 62, 68, and 70, Appellants have not met the burden of showing the Examiner erred in rejecting claims 72-75 under 35 U.S.C. § 103(a) for obviousness over Livingston, Habib, Coleman, and Connors.

DECISION

The Examiner's rejection of claims 56, 59-62, 65-68, 70 and 76-82 under 35 U.S.C. § 103(a) as being obvious over Livingston, Habib and Coleman is affirmed.

The Examiner's rejection of claims 72-75 under 35 U.S.C. § 103(a) as being obvious over Livingston, Habib, Coleman, and Connors is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

nhl

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